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In the Supreme Court of the United States

OCTOBER TERM, 1951

No. 87

HAROLD R. DALTON AND AUSTIN G. COOLEY,
PETITIONERS

v.

JOHN A. MARZALL, AS COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinions of the Court of Customs and Patent Appeals (R. 90-100) are reported at 188 F. 2d 170.

JURISDICTION

The decision of the Court of Customs and Patent Appeals was entered on March 6, 1951 (R. 100-101). A petition for rehearing was denied on April 10, 1951 (R. 122). The petition for a writ

of certiorari was filed on May 31, 1951. Petitioners invoke the jurisdiction of this Court under 28 U.S.C. 1256. If this Court has any jurisdiction at all to review decisions rendered by the Court of Customs and Patent Appeals on patent matters under R. S. 4914 (35 U.S.C. 62), it may be assumed that the petition was filed in time.

QUESTION PRESENTED

Whether this Court has jurisdiction to issue a writ of certiorari to review a decision of the Court of Customs and Patent Appeals affirming a determination by the Board of Appeals of the Patent Office declining to allow certain claims in an application for a patent.

STATUTES INVOLVED

The pertinent parts of the statutes involved are set forth in the Appendix, *infra*, pp. 11-14.

STATEMENT

Petitioners, claiming to be the original and first inventors of certain new and useful improvements in "Telefacsimile Recording and Duplicating Paper," filed an application with the United States Patent Office for a patent on the claimed invention (R. 3-17). Claims 21, 23 to 36, inclusive, and 39, included in petitioners' application, were finally denied by the Board of Appeals of the United States Patent Office, as lacking invention, and Claims 12, 13, 15, 16, and 18 were rejected "as not

readable on the elected species" (R. 45, 46). On appeal to the United States Court of Customs and Patent Appeals, the decision of the Board of Appeals was affirmed (R. 90-98, 100-101).

ARGUMENT

We submit that the decision of the court below is correct in every respect for the reasons set forth in the majority opinion and would not in any event warrant review. Moreover, the decisions of this Court show that this Court lacks both constitutional and statutory authority to review this class of case.

This Court has long held that it has no constitutional power to review lower court decisions rendered in summary appeals authorized by R.S. 4914, *infra,* pp. 11-12, to be taken from determinations made by the Patent Office in connection with applications for the grant of patents or the registration of trademarks.[1] In the case of *Postum Cereal Com-*

[1] The history of the summary appeal authorized by R. S. 4914, *infra,* pp. 11-12, is briefly, as follows:

Prior to 1893, authority to hear summary appeals from decisions of the Commissioner of Patents in patent matters was vested in the Supreme Court of the District of Columbia, sitting en banc. See R. S. 4911-4912. By the Act of February 9, 1893, 27 Stat. 434, 436, Congress created the Court of Appeals of the District of Columbia and transferred to that court the authority formerly vested in the Supreme Court of the District of Columbia to hear summary appeals taken from decisions of the Commissioner of Patents in patent matters. By Section 9 of the Act of February 20, 1905, 33 Stat. 724, 727, Congress vested the Court of Appeals of the District of Columbia with jurisdiction to hear summary appeals from decisions of the Commissioner of Patents in trademark matters, and provided that the practice and procedure applicable to sum-

pany v. *California Fig Nut Company,* 272 U.S. 693, a trademark case, this Court in a comprehensive opinion held that a decision of the Court of Appeals of the District of Columbia in such an appeal proceeding was "not a judicial judgment," but was "merely an instruction * * * by a court which is

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mary patent appeals should govern the summary trademark appeals. At all times, R. S. 4914 has provided, and still provides that the decision of the court in a summary appeal shall not preclude any person interested from the right to contest the validity of the patent involved in the appeal in any court wherein the same may be called in question. This provision applies as well to trademark registration summary appeals. By the Act of March 2, 1929, c. 488, 45 Stat. 1475-1476, *infra*, p. 11, Congress changed the name of the Court of Customs Appeals to the Court of Customs and Patent Appeals and transferred to that court from the Court of Appeals of the District of Columbia authority to hear summary appeals from Patent Office determinations in both patent and trademark matters.

Until 1927, R. S. 4915 provided that if a patent should be refused by either the Commissioner of Patents or the Court of Appeals of the District of Columbia, the applicant might have a remedy by bill in equity filed in the Supreme Court of the District of Columbia (now the United States District Court for the District of Columbia), which court might adjudge that the applicant was entitled to the patent. In *American Foundries* v. *Robertson*, 262 U. S. 209, this Court held that R. S. 4915 was applicable to trademark registrations as well as to patent applications. Thus, as the law then stood, an applicant had a right to both the summary appeal and the remedy by bill in equity. By the Act of March 2, 1927, c. 273, 44 Stat. 1335, 1336-1337, Congress amended R. S. 4911 and 4915 to provide that an applicant to whom a patent should be refused might proceed either by summary appeal or by bill in equity, but if he should proceed by way of summary appeal he would waive his right to proceed by way of a bill in equity. As thus amended, R. S. 4911 and 4915, *infra*, pp. 12-14, now give an applicant who has been refused a patent an election to proceed either by summary appeal or by bill in equity, but he may no longer have the benefit of both remedies. See 35 U.S.C. 59a and 63. See also the Act of July 5, 1946, 60 Stat. 435; 15 U.S.C. 1071, which expressly gives an applicant for a trademark registration the same election of remedies.

made part of the machinery of the Patent Office for administrative purposes" (pp. 698-699). Consequently, such a proceeding was considered not to be a case or controversy, in the constitutional sense, which this Court was authorized to review. See also *Pacific Northwest Canning Company* v. *Skookum Packers' Ass'n,* 283 U. S. 858 (a trademark case), and *McBride* v. *Teeple,* 311 U.S. 649 (a patent case), wherein this Court, citing the *Postum Cereal Company* case, held that it had no jurisdiction to review summary appeals taken from Patent Office determinations in patent and trademark matters. This Court has also, without comment as to jurisdiction, declined to review a long list of other decisions in summary appeals taken from determinations of the Patent Office in patent and trademark matters. See *Panhard Oil Corp.* v. *Societe Anonyme,* 282 U. S. 858; *I. G. Farbenindustrie* v. *Lacy,* 282 U.S. 870; *Fessenden* v. *Wilson,* 284 U.S. 640; *Laughlin* v. *Robertson,* 284 U.S. 652; *United States Gypsum Co.* v. *Plastoid Products, Inc.,* 284 U.S. 635; *Keller, Heumann & Thompson Co., Inc.* v. *Coe,* 298 U.S. 656; *Chase* v. *Avery,* 307 U.S. 638; *Galena Manufacturing Co.* v. *Superior Oil Works,* 308 U.S. 609; and *A. J. McPartland, Inc.* v. *Montgomery Ward & Co., Inc.,* 333 U.S. 875.

In the earlier cases of *Frasch* v. *Moore,* 211 U.S. 1 (a patent case), *Atkins & Company* v. *Moore,* 212 U.S. 285 (a trademark case), *Gaines* v. *Knecht,* 212 U.S. 561-562 (a trademark case), and *Baldwin*

Company v. *Howard Company,* 256 U.S. 35 (a trademark case), this Court had declined to review summary appeal decisions on the ground that such decisions were not final judgments within the meaning of Section 8 of the Act of February 9, 1893, 27 Stat. 434, 436, which authorized it generally to review "final judgments" of the Court of Appeals of the District of Columbia.[2] In the *Postum Cereal Company* case, this Court agreed that the decisions in those cases were not final judgments, but pointed out (page 699) that that fact "should not be understood to imply that, in such a proceeding, circumstances might give it a form that would make it a final judgment subject to review by this Court." Thus, this Court made it clear that its decision in the *Postum Cereal* case was not based upon lack of finality in the decision of the appellate court but upon the nature of the proceeding. And the fact that when that case was decided an applicant might bring a bill in equity even after pursuing his appellate remedy, whereas since the passage of the Act of March 2, 1927, 44 Stat. 1335, 1336, the appellate and bill-in-equity remedies are mutually exclusive, would not appear to be significant with respect to the constitutional authority of this Court to review

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[2] In the case of *Estate of P. D. Beckwith, Inc.* v. *Commissioner of Patents,* 252 U.S. 538, the Court granted a writ of certiorari and reviewed the summary appeal decision in a trademark case. In that case, however, the jurisdictional question was not raised, and in *Baldwin Company* v. *Howard Com-*

summary appeal decisions in patent or trademark matters. This, we believe, is confirmed by the fact that after the two remedies were made mutually exclusive this Court, in denying the writs for want of jurisdiction in *Pacific Northwest Canning Co.* v. *Skookum Packers' Ass'n,* 283 U.S. 858, and *McBride* v. *Teeple,* 311 U.S. 649, relied expressly upon its prior holding in the *Postum Cereal Company* case.

Petitioners invoke 28 U.S.C. 1256 to sustain the jurisdiction of this Court to grant the writ of certiorari and review the decision of the court below.[3] Petitioners' reliance on that section overlooks the holding of this Court in the *Postum Cereal Company* case, *supra,* that it has no constitutional power to review decisions in summary appeals taken from determinations of the Patent Office in patent and trademark matters, since such proceedings and the review thereof are administrative, not judicial in nature. Thus, whether or not the language of 28 U.S.C. 1256 may be considered as being broad enough to include all cases in the Court of Customs and Patent Appeals, the section is not effective to authorize this Court to review summary appeals of this character, since such proceedings are not cases or controversies

pany, 256 U.S. 35, this Court characterized its grant of the writ of certiorari in the *Beckwith* case as being inadvertent and not establishing jurisdiction.

[3] Sec. 1256: "Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari."

in the constitutional sense. At the time the *Postum Cereal Company* case was decided, this Court was authorized by Section 240(a) of the Judicial Code, as amended by the Judiciary Act of 1925, 43 Stat. 936, 938-939 (see 28 U.S.C. (1946 ed.) 347, now 28 U.S.C. 1254), to review "any case" in the Court of Appeals of the District of Columbia, but the mere fact that the language of the authorizing statute was broad enough to include all cases which the court of appeals was authorized to hear and determine could not make the statute operate to vest this Court with jurisdiction over a proceeding not included in the constitutional grant of judicial power.

Furthermore, we believe it highly unlikely that Congress, when it passed the Act of June 25, 1948, 62 Stat. 869, codifying into law Title 28 of the United States Code, intended that the new Section 1256 of that Title should have the effect of enlarging this Court's jurisdiction to review decisions of the Court of Customs and Patent Appeals rendered in summary appeals in patent and trademark matters. Prior to the effective date of the 1948 Act, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was Section 195 of the Judicial Code, as amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 647 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U.S.C. (1946 ed.) 308. That section, which empowered

the Court of Customs and Patent Appeals to hear appeals from the Customs Court and authorized this Court to review the decisions of the Court of Customs and Patent Appeals in such cases, related only to customs cases. It did not refer to either patent or trademark matters. In the codifying act, Congress merely separated the two provisions, placing in 28 U.S.C. 1541 the authority of the Court of Customs and Patent Appeals to hear appeals in customs cases, and in Section 1256 the authority of this Court to review by writ of certiorari cases in the Court of Customs and Patent Appeals. We have found nothing in the codifying act or its history to indicate that there was a conscious effort on the part of Congress to give this Court authority to review a class of cases over which its jurisdiction had previously been withheld. And there would seem to be no plausible reason to impute to that body an intention to do so, especially since the classes of proceedings over which jurisdiction was previously withheld were the same as those which this Court in the *Postum Cereal Company* case had held it was without constitutional power to review.

The Commissioner of Patents desires it to be stated that his office has no special interest in either sustaining or contesting the jurisdiction of this Court to review summary appeal decisions of the Court of Customs and Patent Appeals in patent or trademark matters. He suggests, how-

ever, that it would be helpful if this Court, in disposing of the instant case, would indicate whether or not it has jurisdiction to review decisions of the Court of Customs and Patent Appeals in such cases.

It is respectfully submitted that the petition for a writ of certiorari should be denied for want of jurisdiction as in *McBride* v. *Teeple,* 311 U.S. 649.

PHILIP B. PERLMAN,
Solicitor General.

JOHN R. BENNEY,
Attorney.

E. L. REYNOLDS,
Solicitor for the Patent Office.

JULY, 1951.

APPENDIX

Act of March 2, 1929, c. 488, 45 Stat. 1475-1476:

> That the title of the United States Court of Customs Appeals, created by the Act approved August 5, 1909, is hereby changed to the United States Court of Customs and Patent Appeals.
>
> Sec. 2(a) The jurisdiction now vested in the Court of Appeals of the District of Columbia in respect of appeals from the Patent Office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals.

28 U. S. C. 1256:

> Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

Section 4914 of the Revised Statutes, 35 U. S. C. 62:

> The court [Court of Customs and Patent Appeals], on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no

opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

Sections 4911 and 4915, R. S., as amended, 27 Stat. 436, 44 Stat. 1335, 1336; 45 Stat. 1476; 53 Stat. 1212; 35 U. S. C. 59a, 63:

Sec. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill of equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

Sec. 4915. Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the

further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 87.

IN THE MATTER

of

The Application of HAROLD R. DALTON and AUSTIN G. COOLEY for United States Letters Patent.

HAROLD R. DALTON and AUSTIN G. COOLEY,
Petitioners,

vs.

JOHN A. MARZALL as Commissioner of Patents,
Respondent.

PETITIONERS' REPLY BRIEF.

JOHN J. ROGAN,
Counsel for Petitioners.

CHARLES A. MORTON,
Of Counsel.

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